

R E M A R K S

Claims 1 and 3-8 are pending and stand ready for further action on the merits. Claim 2 has been canceled. Claims 4-7 have been amended to depend from both claims 1 and 3. Support for new claim 8 can be found in claim 1 and in the Examples of the present specification. No new matter has been added by way of the above amendments.

Prior Art Based Issues

The following prior art based rejections are pending:

- (a) claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hensen, Jr. et al. (U.S. Patent 5,272,175; and
- (b) claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hensen, Jr. et al.

Applicants respectfully traverse the rejection.

Applicants respectfully submit that claim 1, as originally filed, is neither anticipated nor rendered obvious by Hensen, Jr. et al. However, in order to advance prosecution, Applicants have amended claim 1 to recite the subject matter of claim 2 and cancelled claim 2. Accordingly, the above prior art based rejections are rendered moot.

Comments on the Patentability of New Claim 8

New claim 8 is essentially of the same scope as claim 1, as originally filed, except that new claim 8 contains proviso (b), which recites that when R¹ and R² are hydrogen atoms or when R¹ is methyl, n is an integer of 4 to 8. Applicants respectfully submit that this proviso excludes the compounds of Hensen, Jr. et al., which are either taught or fairly suggested. First, Applicants note that the closest exemplified compounds of Hensen Jr. et al. i.e., compounds 24 and 42, are not encompassed by new claim 8. Second, Applicants respectfully submit that Hensen Jr. et al. do not fairly suggest compounds containing an alkylene chain between the two amino acid nitrogens having at least four carbon atoms connecting the two amino acid nitrogens. In each of the exemplified compounds of Hensen Jr. et al., the alkylene chain between the two amino acid nitrogens necessarily have a total of 2 carbon atoms connecting the two amino acid nitrogens.

A reference which leads one of ordinary skill in the art away from the claimed invention cannot render it unpatentably obvious. *Dow Chem. Co. v. American Cyanamid Co.* 816 F2d 617, (CAFC 1987). In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention." *Akzo N.V. v. United States Int'l Trade Comm'n*, 1

USPQ2d 1241, 1246 (Fed. Cir. 1986); *In re Fine*, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988).

Applicants respectfully submit that Hensen Jr. et al. teaches away from the inventive compounds, in that the each of the exemplified compounds of Hensen Jr. et al. contain a total of 2 carbon atoms connecting the two amino acid nitrogens. As such, significant patentable distinctions exist between new claim 8 and the teachings of Hensen Jr. et al.

Conclusion


In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner, #32,181

Garth M. Dahlen, Ph.D., #43,575

MSW/GMD:bmp
0020-4955P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s) :

(Rev. 02/12/2004)